

ESTTA Tracking number: **ESTTA448918**

Filing date: **12/30/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050998
Party	Defendant Aguila Records Inc.
Correspondence Address	J ARON CARNAHAN HUSCH BLACKWELL SANDERS LLP WELSH & KATZ 120 S RIVERSIDE PLAZA, 22ND FLOOR CHICAGO, IL 60606 UNITED STATES jacdocket@welshkatz.com, aron.carnahan@huschblackwell.com
Submission	Response to Board Order/Inquiry
Filer's Name	J. Aron Carnahan
Filer's e-mail	aron.carnahan@huschblackwell.com
Signature	/J. Aron Carnahan/
Date	12/30/2011
Attachments	rESPONSE TO bOARD cancellation.pdf ( 7 pages )(29663 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Oscar Urbina, Jr.	
Plaintiff	Cancellation No. 92/050,998
v.	Registration No. 3,170,684
Aguila Records, Inc.	Mark: ALACRANES MUSICAL
Registrant	

**REGISTRANT’S RESPONSE TO TTAB ORDER OF 12/2/11**

Registrant Aguila Records, Inc. (hereinafter “Registrant”) hereby responds to this Board’s Order of December 2, 2011, which Order requested the status of the civil action that occasioned the suspension of these proceedings.

The federal trademark infringement lawsuit that occasioned the stay of this Cancellation proceeding is case 09cv3399, which was pending in the Federal District Court for the Northern District of Illinois (hereinafter “Federal Lawsuit.”). On June 14, 2011, Judge Zagel entered an Order dismissing the Federal Lawsuit. Judge Zagel’s Order stated:

Case is dismissed pursuant to FRCvP 41(a)(1)(A)(ii) with prejudice and without costs. Civil case terminated. Mailed notice.

Attached Exhibit A.

Pursuant to an underlying settlement agreement between Cancellation Plaintiff and Registrant, current ownership of the trademark at issue here was granted to Registrant. This Settlement Agreement was executed on June 6, 2011 by Registrant, and was executed on April 5, 2011 by Cancellation Plaintiff. The Federal Litigation was dismissed pursuant to the Settlement Agreement.

The Settlement Agreement contains numerous terms not relevant to this dispute

(including social security numbers), and confidentiality concerns prohibit Registrant from publicly submitting a copy of the Settlement Agreement to this Board. Registrant was desirous of providing a joint statement from Plaintiff and Registrant to this Board concerning the dismissal of the Federal Litigation and the parties' settlement, but the undersigned was unable to reach counsel for Plaintiff (Mr. Alonzo Yocel). The undersigned left two voice-mail messages for Plaintiff's counsel over a period of three weeks and followed up with an e-mail (attached Exhibit B), but has not received a response from counsel for Plaintiff.

Because the underlying litigation has been dismissed and the settlement between the parties awards current ownership of the trademark at issue here to Registrant, Registrant respectfully submits that this Cancellation should be dismissed.

December 30, 2011

Respectfully submitted,

AGUILA RECORDS, INC.

By: /s/ J. Aron Carnahan  
J. Aron Carnahan  
Richard J. Gurak  
Husch Blackwell LLP  
120 S. Riverside Plaza, 22<sup>nd</sup> Floor  
Chicago, IL 60606  
(312) 655-1500

Attorneys for Registrant

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing document was served via E-Mail and First Class Mail on this the 30<sup>th</sup> day of December, 2011 upon counsel for Plaintiff:

Yocel Alonso  
130 Industrial Boulevard, Suite 110  
PO Box 45  
Sugar Land, TX 77487-0045  
yocelaw@aol.com

/s/ J. Aron Carnahan.  
Attorney for Applicant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Oscar Urbina, Jr.		
	Plaintiff	Cancellation No. 92/050,998
v.		Registration No. 3,170,684
Aguila Records, Inc.		Mark: ALACRANES MUSICAL
	Registrant	

**Exhibit A**

To Applicant's Response to TTAB Order of 12/2/2011

**UNITED STATES DISTRICT COURT  
FOR THE Northern District of Illinois – CM/ECF LIVE, Ver 4.2  
Eastern Division**

Aguila Records, Inc., et al.

Plaintiff,

v.

Case No.: 1:09–cv–03399

Honorable James B. Zagel

Nueva Generacion Music Group, Inc., et al.

Defendant.

---

**NOTIFICATION OF DOCKET ENTRY**

This docket entry was made by the Clerk on Tuesday, June 14, 2011:

MINUTE entry before Honorable James B. Zagel: Case is dismissed pursuant to FRCvP 41(a)(1)(A)(ii) with prejudice and without costs.Civil case terminated. Mailed notice(drw, )

**ATTENTION:** This notice is being sent pursuant to Rule 77(d) of the Federal Rules of Civil Procedure or Rule 49(c) of the Federal Rules of Criminal Procedure. It was generated by CM/ECF, the automated docketing system used to maintain the civil and criminal dockets of this District. If a minute order or other document is enclosed, please refer to it for additional information.

For scheduled events, motion practices, recent opinions and other information, visit our web site at [www.ilnd.uscourts.gov](http://www.ilnd.uscourts.gov).

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Oscar Urbina, Jr.		
	Plaintiff	Cancellation No. 92/050,998
v.		Registration No. 3,170,684
Aguila Records, Inc.		Mark: ALACRANES MUSICAL
	Registrant	

**Exhibit B**

To Applicant's Response to TTAB Order of 12/2/2011

**Carnahan, J. Aron**

---

**From:** Carnahan, J. Aron  
**Sent:** Wednesday, December 28, 2011 10:49 AM  
**To:** 'yocelaw@aol.com'  
**Cc:** Gurak, Richard  
**Attachments:** ttabvue-92050998-CAN-18.pdf

Yocel-- I write concerning Cancellation proceeding 92050998 involving Oscar Urbina, Jr. and Aguila Records, Inc. concerning the mark "Alacranes Musical."

As you may be aware, the TTAB issued an Order requiring the parties to update the TTAB with the status of the civil action that occasioned the stay of the Cancellation proceeding. We owe a response to the TTAB by Dec. 30. I have left two messages with you but have been unable to reach you.

It is my understanding that Mr. Oscar Urbina, Jr. and Aguila Records settled the underlying lawsuit (case 09 cv 3399, N.D.Ill.), and that the cancellation proceeding should be dismissed by Mr. Urbina under the settlement agreement. If I do not hear from you imminently, I will respond to the TTAB Order with the foregoing facts.

Thank you,

Aron

**J. Aron Carnahan**  
**Partner**

**HUSCH BLACKWELL LLP**  
120 South Riverside Plaza, Suite 2200  
Chicago, IL 60606  
Direct: 312.526.1612  
Fax: 312.655.1501  
[aron.Carnahan@huschblackwell.com](mailto:aron.Carnahan@huschblackwell.com)  
[huschblackwell.com](http://huschblackwell.com)  
[View Bio](#) | [View VCard](#)

12/30/2011